UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/506,386 | 09/02/2004 | Marc Bednarz | 11610-16 | 1647 |

20694 7590 09/11/2008

WOLFF & SAMSON, P.C.
ONE BOLAND DRIVE
WEST ORANGE, NJ 07052

| EXAMINER | |
|---|---|
| WANG, EUGENIA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1795 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/11/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/506,386 | BEDNARZ ET AL. | |
| | Examiner | Art Unit | |
| | EUGENIA WANG | 1795 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 22 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that although D'Alessandro et al. applies a current, electrolysis is not present.

Examiner respectfully disagrees with Applicant's position. As set forth in the rejection, D'Alessandro does teach the method as claimed by the instant application, wherein steam (water vapor) is provided to the anodes as well as external voltage. Accordingly, a basis of inherency was made. It is maintained herein, as no proof or showing is provided that the process used by D'Alessandro would not inert via electrolysis of the steam (water vapor). There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67.

Applicant argues that D'Alessandro et al. do not disclose an external voltage to the fuel cells to produce a reducing atmosphere at the anodes by electrolysis.

Examiner respectfully disagrees with Applicant's position. Again, it is emphasized that D'Alessandro does teach the method as claimed by the instant application. Accordingly, it would be inherent that the same conditions (reducing by electrolysis). Such a rejection is maintained herein, as no proof or showing is provided that the process used by D'Alessandro would not inert via electrolysis of the steam (water vapor). Additionally, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67.

Applicant argues that D'Alessandro et al. do not disclose the method step of applying an external voltage to the fuel cells to produce a reducing atmosphere at the anodes by electrolysis, since no electrolysis takes places as the anode is only flushed with inert gases.

Examiner respectfully disagrees with Applicant's position. The fact that D'Alessandro et al. does teach of flushing with inert gases, it does not negate the fact that steam is taught to be used, wherein steam (water vapor) electrolyzes upon the application of a current. It also does not negate the fact that D'Alessandro does teach the method as claimed by the instant application. Therefore, a basis of inherency was made and is maintained. As no proof is provided that the process used by D'Alessandro would not inert via electrolysis of the steam (water vapor). There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67.

Applicant argues that Examiner has not set forth a basis in fact/technical reasoning as to inherency (because Examiner only asserts that D'Alessandro et al.'s method uses the same steps as that of the instant application).

Examiner respectfully disagrees and submits that a clear basis for inherency has been set forth. Such position is reiterated herein for clarity's sake: "In the case of the instant application the basis for expectation of inherency is that D'Alessandro et al.'s method uses steps employed by the instant application. Therefore, the resulting state of the anodes would be in the same state (inert) after the application of the same method." Examiner is unsure as to why such a basis does not have any factual and/or technical reasoning. The basis of inherency lies in the fact that since the method of D'Alessandro et al. is the same as that of the instant application, it would provide the same conditions. It is uncertain how the same method would not provide the same outcome. Accordingly, Examiner submits that the basis of inherency has been properly set forth. It is noted that in response to this, Applicant has not provided any convincing proof or reasoning as to how D'Alessandro et al.'s system, which operates in the same method as claimed by the instant application would not provide the same conditions.

Applicant again argues that D'Alessandro et al. does not specifically disclose that electrolysis takes place, and thus one of ordinary skill in the art would take from the teaching of D'Alessandro et al. that the voltage is smaller than the decomposition voltage.

Examiner respectfully disagrees. First, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67. Accordingly, as set forth in the rejection, electrolysis would be inherent. Additionally, Examiner would like to submit that D'Alessandro et al.'s teaching does leave reasonable expectation that the decomposition voltage is met. D'Alessandro et al. clearly teaches that a potential of at least 3 volts is applied, and it is further noted that even higher potentials may be used (col. 3, lines 7-36). It is uncertain that how a teaching applying 3 volts or higher would not result in the electrolysis as claimed. There has been no proof provided as to how this voltage is smaller than the decomposition voltage. Furthermore, Examiner would like to bring to light that, Electrochemistry I, provided by Applicant, states that decomposition voltages for electrolyses are between 1-4 volts. Accordingly, one of ordinary skill in the art would gather that the teaching of 3 volts or higher potential would be sufficiently high to electrolyze water, barring proof showing the contrary.

Applicant argues that Examiner makes conclusory statements on inherency without providing basis and fact and/or technical reasoning for.

Examiner respectfully disagrees. As set forth within the rejection, and previously within the response, Examiner has properly set forth the basis for inherency. Such a position is reiterated herein for clarity's sake: "In the case of the instant application the basis for expectation of inherency is that D'Alessandro et al.'s method uses steps employed by the instant application. Therefore, the resulting state of the anodes would be in the same state (inert) after the application of the same method." Examiner is unsure as to why such a basis does not have

any factual and/or technical reasoning. The basis of inherency lies in the fact that since the method of D'Alessandro et al. is the same as that of the instant application, it would provide the same conditions. It is uncertain how the same method would not provide the same outcome. Accordingly, Examiner submits that the basis of inherency has been properly set forth. It is noted that in response to this, Applicant has not provided any convincing proof or reasoning as to how D'Alessandro et al.'s system, which operates in the same method as claimed by the instant application would not provide the same conditions.

Applicant argues that since D'Alessandro et al. names steam as a suitable inert gas, no electrolysis would take place.

Examiner respectfully disagrees with Applicant's position. The fact that D'Alessandro et al. does teach of flushing with inert gases, it does not negate the fact that steam is taught to be used, wherein steam (water vapor) electrolyzes upon the application of a current. Accordingly, D'Alessandro et al. teach the method as claimed by the instant application. Therefore, a basis of inherency was made and is maintained because no proof, showing, or reasoning has provided that the process used by D'Alessandro would not inert via electrolysis of the steam (water vapor). In such a manner, Applicant is merely making conclusory statements and does not clearly show that the method of D'Alessandro et al. and the instant application do in fact differ. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67..